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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,161	10/29/2003	Peter C. Morris	200310633-1	7627

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EXAMINER
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SHAH, MANISH S

ART UNIT	PAPER NUMBER
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2853

DATE MAILED: 02/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/696,161

Applicant(s)

MORRIS ET AL.

Examiner

Manish S. Shah

Art Unit

2853

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-15 and 17-22 is/are rejected.
- 7) ☒ Claim(s) 6, 16 and 22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-5, 7-8, 11-15, 17-18 & 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Behm. William F. (# US 5286061).

Behm William F. discloses an inkjet recording method and an ink-jet printing system (column: 7, line: 20-25) including a substrate (element: 12, 32; figure: 1-9); a visible inkjet ink composition configured to be ink jetted onto at least a portion of the substrate to form a first visible image on the substrate (black ink) (element: 14, 16, 34, 54; figure: 1-9; column: 6, line: 45-55); a first invisible composition configured to be ink jetted onto at least a portion of the substrate to form an invisible image on the substrate, the invisible image being associated with the first visible image (invisible color ink) (column: 6, line: 60-66; column: 7, line: 12-25); and a second invisible composition (developing agent) configured for over-striking at least a portion of the invisible image, wherein the first and second invisible composition are further configured to react and form a second visible image on the substrate (invisible color ink ) (see Abstract; column: 6, line: 15-20). They also disclose that the first and second invisible composition is an invisible ink (column: 7, line: 23-67). They also disclose that the second visible image is

fluorescent (column: 7, line: 35-67). They also disclose that the first visible image is a character and second visible image is highlight or underline (figure: 1-9).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 9-10 & 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Behm. William F. (# US 5286061) in view of Sokol et al. (# US 4198445).

Behm. William F. discloses all the limitation of the ink jet printing system and inkjet recording method. They also disclose that the developer includes active ingredient selected from metal hydroxide or alkyl amines or polyamines (column: 7, line: 55-68).

Behm. William F. discloses all the limitation of the ink jet printing system and inkjet recording method except that the invisible ink includes a developable colorant selected from phenolphthalein.

Sokol teaches that to get the ink with longer fading time with developer, invisible ink includes a developable colorant selected from phenolphthalein (column: 2, line: 44-55).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invisible ink composition of Behm. William F. by the aforementioned teaching of Sokol et al. in order to ink with a longer fading time, which increases the storage stability of the printed image.

### ***Allowable Subject Matter***

3. Claims 6, 16 & 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

(1) The third invisible composition configured for over-sticking at least a portion of the second visible image, wherein the third composition and the over-stricken portion of the second visible image are further configured to react and become colorless.

### ***Response to Arguments***


4. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manish S. Shah whose telephone number is (571) 272-2152. The examiner can normally be reached on 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen D. Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Manish S. Shah  
Primary Examiner  
Art Unit 2853

MSS

2/21/06